

REMARKS

Fifty claims were originally filed in the present Application, and claims 51 through 69 were subsequently added. Claims 1-56 and 58-69 currently stand rejected, and claim 57 is objected to, but would be allowable if amended to include the limitations of the corresponding independent claim 51. Claims 1, 24, 48, 51, 57, 60, and 62 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 112, First Paragraph

In paragraph 3 of the Office Action, the Examiner indicates that claims 48, 60, and 62-65 are rejected as “failing to comply with the written description requirement.” In response, Applicants herein amend claims 48, 60, and 62-65 to substitute the word “format” for the word “transmission”. Support for the foregoing changes may be found on page 14, lines 9-19, of the Specification. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s rejection is addressed, and respectfully request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn so that claims 48, 60, and 62-65 may issue in a timely manner.

Rejection under 35 U.S.C. §112, Second Paragraph

In paragraph 6 of the Office Action, the Examiner indicates that claim 48 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner indicates that “it is unclear . . . where the customer account information is being attached - in the image pump or at the image source.” Furthermore, the Examiner asks “[i]f the customer information is being attached at the image pump, it is unclear how this could be done without a processor.”

Applicants refer the Examiner to page 15, lines 9-19, of the Specification, which teaches that the customer account information may alternately be stored in either the image pump or the image source (digital camera 110). Claim 48 is therefore not limited to one location for attaching the customer account information. With regard to how the image pump could attach the customer account information to image data without a processor, Applicants submit that the image pump may utilize any appropriate techniques to attach the customer account information without utilizing a processor. For example, in certain embodiments, image pump could readily attach the customer account information by utilizing appropriate device hardware. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s rejection is addressed, and respectfully requests that the rejection under 35 U.S.C. §112, second paragraph be withdrawn so that claim 48 may issue in a timely manner.

35 U.S.C. § 102(e)

In paragraph 8 of the Office Action, the Examiner rejects claims 1-3, 5-6, 11-17, 22-26, 28-29, 34-40, 45-47, 51-54, and 66-68 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,147,742 to Bell et al. (hereafter Bell). The Applicants respectfully traverse these rejections.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Bell fails to identically teach every element of the claims, and therefore, does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1, 24, and 51, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1, 24, and 51, which are amended herein to recite “*a system user instructing said image pump to transfer said image data from said image pump to said service provider by activating image-data transfer means of said image pump,*” and which are limitations that are not taught or suggested either by Bell or by the Examiner’s citations thereto.

Bell essentially teaches an automatic photofinishing system without any intermediary image pump between the image data source and the photofinishing system. In paragraph 20 of the Office Action, the Examiner argues that “figure 1 clearly depicts the order manager (22) implemented

separately (and in a non-integral manner) from the image source (26) and the service provider” Applicants respectfully disagree.

Bell specifically stipulates “[r]eferring now to FIG. 1, the photofinishing system of the present invention, generally designated 20, provides an automatic and integrated means to carry out photofinishing services. The system includes an order manager 22” (column 3, lines 44-47).

Applicants have previously amended claims 1 and 24 to clarify that the claimed “service provider” is implemented to include “a photofinishing system”.

Applicants therefore submit that Bell fails to disclose an image pump that is “implemented separately from said image source and said service provider, *in a non integral manner*, for transferring said image data from said image source to said service provider,” as recited by Applicants in amended claims 1 and 24.

Furthermore, with regard to the claimed limitations of “said image pump being implemented in a simplified configuration without an internal processor,” the Examiner states that “there is no indication in Bell that the order manager contains a processor” Applicants respectfully disagree, and submit that the discussion of FIG. 3 in Bell (column 5, lines 1-34) provides more than an “indication” of processor functionality.

For example, the order manager of Bell is specifically described as performing various complex processor functions such as checking for new incoming orders, managing the workflow of previously received orders, cataloguing new requests for workload management, identifying customer name, address, services requested, job identification number, merge code,

image status, etc., compiling a workflow sequence, receiving notifications from peripheral units, making various determinations regarding order completion, and removing data from the catalogue. Applicants therefore respectfully submit that Bell teaches and discloses an order manager implemented with a processor. Applicants also hereby incorporate the foregoing arguments with regard to independent claim 66. For at least the foregoing reasons, Applicants therefore submit that the rejections of claims 1, 24, 51, and 66 under 35 U.S.C. § 102(e) are improper.

Regarding the Examiner's rejection of dependent claims 2-3, 5-6, 11-17, 22-23, 25-26, 28-29, 34-40, 45-46, 52-54, and 67-69, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claims 2-3, 5-6, 11-17, 22-23, 25-26, 28-29, 34-40, 45-46, 52-54, and 67-69 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Bell to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 1-3, 5-6, 11-17,

22-26, 28-29, 34-40, 45-46, 51-54, and 66-68 so that these claims may issue in a timely manner.

In paragraph 10 of the Office Action, the Examiner rejects claims 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of U.S. Patent No. 5,974,401 to Enomoto (hereafter Enomoto). Applicants respectfully traverse for at least the following reasons.

The Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

With regard to claims 55 and 56, the Examiner states that “it would have been obvious . . . to have modified Bell by the teachings of Enomoto in order to give the user greater control in image selection.” Applicants submit that the cited references nowhere overtly teach or suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants respectfully request the Examiner to provide specific teachings *from the cited references* that establish an explicit motivation for combining these references, or alternately, to withdraw the foregoing rejections so that the rejected claims may issue in a timely manner.

In paragraph 12 of the Office Action, the Examiner rejects claims 49 and 50 under 35 U.S.C. § 102(e) as being anticipated by Enomoto. The Applicants respectfully traverse these rejections.

As previously stated, “For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Enomoto fails to identically teach every element of the claims, and therefore, does not anticipate the present invention.

Enomoto essentially teaches providing image data from an input device to a user’s “*personal computer*” for processing and generation of “print order data”. The personal computer may then send the processed image data and the print order data to a photofinisher for processing (column 1, line 52 to column 2, line 31). Apparently, the Examiner analogizes the personal computer of Enomoto to Applicants’ “image pump”. Applicants respectfully disagree with this interpretation of Enomoto.

With regard to claim 50, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 24, as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 50. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 50, should be construed in light of the Specification. More specifically, means-plus-function claim

elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicants respectfully submit that, in light of the substantial differences between the teachings of Enomoto and Applicants' invention as disclosed in the Specification, claim 50 is therefore not anticipated or made obvious by the teachings of Enomoto. Applicants specifically direct the Examiner's attention to Applicants' discussions of FIGS. 1, 2, 3, and 8 (Specification, page 6, line 27 through page 9, line 7, and page 13, line 26 through page 14, line 25) which describe in further detail the Applicants' claimed "means for sending said image data to an image pump" and "means for sending said image data to said service provider utilizing said image pump."

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Enomoto to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 49 and 40, so that these claims may issue in a timely manner.

In paragraph 14 of the Office Action, the Examiner rejects claims 62 and 64 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,167,469 to Safai et al. (hereafter Safai). The Applicants respectfully traverse these rejections.

As previously stated, "For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically*

shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Safai fails to identically teach every element of the claims, and therefore, does not anticipate the present invention.

With regard to claims 62 and 64, the Examiner states that “Safai discloses . . . reviewing the order and providing services to the user”, and cites “column 7, lines 4-8” of Safai as support. Applicants respectfully submit that column 15, lines 17-58 of Safai nowhere teaches “*reviewing said image data and said customer account information for accuracy and format errors*” as recited in claim 62.

More specifically, in paragraph 20 of the Office Action, the Examiner states that “*Enomoto* clearly discloses determining if the image data and customer information have errors (which reads on if the delivery data exceeds the expected delivery date).” Applicants respectfully disagree. Applicants submit that merely checking delivery dates fails to read on reviewing for “accuracy and format errors” as claimed by Applicants in amended claim 62.

Regarding the Examiner’s rejection of dependent claim 64, for at least the reasons that this claim are directly dependent from independent claim 62 whose limitations are not identically taught or suggested, the limitations of these claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner

fails to cite Safai to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 62 and 64 so that the present Application may issue in a timely manner.

Rejections under 35 U.S.C. §103

In paragraph 16 of the Office Action, the Examiner rejects claims 4, 18-19, 27, 41-42, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of U.S. Patent No. 6,157,436 to Cok (hereafter Cok). Applicants respectfully traverse for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to claims 4 and 27, the Examiner states that Bell "does not clearly disclose the image source communicates with the image pump by wireless means". Applicants concur. The Examiner then points to Cok to

remedy this deficiency, and concludes that “[i]t would have been obvious . . . to have modified Bell by the teaching of Cok” The Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Applicants submit that the cited references nowhere teach or suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants respectfully request the Examiner to provide specific teachings *from the cited references* that establish an explicit motivation for combining these references, or alternately, to withdraw the foregoing rejections so that the rejected claims may issue in a timely manner.

In addition, with regard to claims 18, 19, 41, and 42, the Examiner states that Enomoto “does not clearly disclose a touch screen.” Applicants concur. The Examiner then points to column 8, lines 1-12 of Cok to purportedly support these rejections, stating that “Cok discloses an operator station comprising a CRT or LCD screen” Applicants respectfully submit that column 8, lines 1-12 of Cok nowhere teaches a “touchscreen” as recited in claims 18, 19, 41, and 42. Applicants therefore request the Examiner to reconsider and withdraw the rejection of these claims.

In paragraph 18 of the Office Action, the Examiner rejects claims 7-10, 20-21, 30-33, 43-44, 58-59, and 60-61 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of Enomoto. Applicants respectfully traverse for at least following reasons.

As discussed above, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references, when combined, teach *all the claimed limitations* of the present invention. Applicants respectfully submit that the cited references fail to disclose certain claimed limitations of the rejected claims.

For at least the reasons that these claims are dependent from independent claims whose limitations are not identically taught or suggested, the limitations of claims 7-10, 20-21, 30-33, 43-44, 58-59, and 60-61, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. For at least the foregoing reasons, Applicants submit that the rejections of claims 7-10, 18-21, 30-33, 41-44, 58-59, and 60-61 are improper, and respectfully request reconsideration and allowance of the rejected claims so that these claims may issue in a timely manner.

In paragraph 19 of the Office Action, the Examiner rejects claims 63 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Safai in view of Enomoto. Applicants respectfully traverse for at least the following reasons.

Applicants submit that neither Safai nor Enomoto teach a service provider “*reviewing said image data and said customer account information for accuracy and format errors*” as claimed by Applicants. Applicants therefore submit that the rejection of claims 63 and 65 under 35 U.S.C. § 103(a) is improper, and respectfully request reconsideration of the rejected claims, so that they may issue in a timely manner.

In paragraph 20 of the Office Action, the Examiner rejects claim 69 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of Cok.

As discussed above, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach *all the claimed limitations* of the present invention. Applicants respectfully submit that the cited references fail to disclose certain claimed limitations of rejected claim 69.

For at least the reason that claim 69 is dependent from independent claim 66 whose limitations are not identically taught or suggested, the limitations of claim 69, when viewed through or in combination with the limitations of independent claim 66, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claim 69 so that this claim may issue in a timely manner.

Combining References

Throughout the Office Action, the Examiner repeatedly states that “it would have been obvious to one of skill in the art” to combine various references. The Examiner then repeatedly provides various corresponding benefits that may result from such combinations as motivation for combining the references. Examples of this type of language may be found, for example, in the rejections of claims 2, 4, 11, 15-17, 23, 25, 27, 34, 38-40, 46, 52-54, 57, 63, and 65.

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention may not act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Applicants suggest that merely because certain isolated aspects from the cited references produce a beneficial result, this fact alone does not provide the requisite teaching for combining references under 35 U.S.C. §103. Applicants therefore respectfully request the Examiner to provide citations to specific sections of the cited references that indicate explicit teachings for combining the references, or in the alternative, to withdraw the rejections under 35 U.S.C. §103 so that these claims may issue in a timely manner.

Allowable Subject Matter


In paragraph 21, the Examiner indicates that claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants therefore amend claim 57 in independent form including all of the limitations of the base claim and any intervening claims, to thereby place claim 57 in condition for immediate allowance.

Summary

Applicants submit that the present Response and amendments herein address and overcome the Examiner's rejections. Because the Examiner's citations and arguments do not teach or suggest Applicants' entire claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-69 so that the present Application may issue in a timely manner. If there are questions or comments concerning this amendment, the Examiner is invited to contact Applicants' undersigned representative at the telephone number provided below.

Respectfully submitted,

Date: 9/23/04

By: 

Gregory J. Koerner, Reg. No. 38,519
SIMON & KOERNER LLP
10052 Pasadena Ave., Suite B
Cupertino, CA 95014
(408) 873-3943